United States Patent No. 5,790,636, issued August 4, 1998 with named inventor Marvin E. Marshall, and is entitled "Telephone Travel Card System Under the Control of Its Customers". The interfering patent will be referred to as the "Marshall '636 patent". The newly presented claims 29-38 are copied from the Marshall '636 patent and claims 33 and 48 correspond to the proposed counts.

Applicant believes that he should be designated as the Senior party in this interference. Applicant Katz is entitled to a priority date of at least May 16, 1988, the filing date of the application issued as USP 4,845,739 (the "'739 patent"), which has substantively the same specification as the present case. In contrast, the Marshall '636 patent on its face purports to have been filed on September 1, 1994 as Application Serial No. 299,397, and includes a designation of a continuation application Serial No. 758,031, filed September 12, 1991.[2]

Before turning to the claims and the proposed count, a brief discussion will be made regarding the commonality of the disclosures. Generally, the disclosures describe systems and methods for the control of telephone calls such as through touch-tone entry of data. More particularly, the disclosed systems and methods capture at least the following three pieces of data:

1. The calling telephone number as obtained automatically through automatic number identification ("ANI"),

2. A Personal Identification Number ("PIN"), and

3. At least one parameter in addition to the preceding, such as time.

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alater point, if and when the interferences are declared, the Board may wish to combine the two cases or divide the proposed Counts, if necessary.

[2] Applicant Katz does not concede the entitlement of the Marshall '636 patent to a filing date of September 12, 1991.

The system and method captures the ANI, the PIN and time (for example) and utilizes them to determine whether the call is entitled to proceed through the system.

Considering this front-end test in more detail, this comparison can be made between disclosures as follows:

Marshall '636 Patent	*Applicant*
"The PC 32 records in its memory that the call was attempted, i.e., all three items (ANI, PIN and time) of data are stored. If two additional invalid calls are attempted from the same telephone (as indicated by ANI) within a predetermined period of time, then the switching station personal computer 32 instructs the DCO switch 22 to permanently block all future call attempts made from that number. Three attempts to make invalid calls thus creates a presumption that the card user is not an authorized user." (column 7, lines 2-11).	"As a further check during the qualification stage, the use-rate calculator 100 may function to determine whether or not an excessive number of calls have originated from the designated number. Thus, consideration involves calls or value with reference to a predetermined period of time. Again, a shared calculator may be used or addressing may obtain selectivity on the basis of calling numbers. If a large number of calls have originated from a single telephone terminal[3], a fraudulent situation may be suggested." (p.36-37:27-2; c.18:35-44).[4]

Assuming that the caller is entitled to enter the system (because of the passage of the front end test on ANI, PIN and time), the caller may at some later time be involuntarily exited from the system. Use of a number to the point of excess or as to utilize all available resources results in termination of the call.

Both applications contain disclosures of cards which bear numbers which may be utilized with the telephone systems. Both applications cite various examples with regard to their application. The Marshall '636 patent identifies a "travel card" (see, e.g., abstract, line 1,

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[3] The specification indicates this may come through use of ANI. (See, e.g., column 4, lines 61-62, "ANI capability is a similar function whereby the digital data indicates the calling number with calling terminal digital signals.")

[4] References to column and line numbers are to United States Patent No. 4,845,739.

summary of the invention, column 1, line 64, and the preambles to the claims), in other words, a card for use in a travel scenario. Applicant Katz' application broadly refers to cards, and variously refers to credit cards usable with a telephone system such as credit cards (e.g., column 17, line 58), products such as cards or tickets which carry a concealed key number (column 17, lines 63-64). The simple designation of "travel" in Marshall cannot be central to Marshall's claims. The claims are directed to use of cards with a telephone system in a touchtone scenario. Accordingly, the proposed Counts delete the abstract designation of "travel" before "cards".

As required by 37 CFR §1.607(a)(5)(i) and (ii), the following table correlates the new claims with the disclosure. The disclosure support is intended to be merely representative, and not exhaustive. Applicants reserve the right to provide further or other support.

APPLICATION OF NEWLY ADDED CLAIMS TO SPECIFICATION[5]

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
39 (29). A telephone system of a type controllable by identification data, comprising:	"In general, the present invention comprises a telephonic-interface system and related process for selectively utilizing both analog (voice) and digital telephonic communication in a variety of different interface formats or programs, as to select or qualify a set of callers, enable positive identification of at least certain of the callers in the set, ..." (p.2:21-27; c.1: 49-56)

[5] Support is referenced to the application page and line numbers, as well as to USP 5,365,575, column and line numbers in the format (page:line; column:line), designated as (p.__:__; c.__:__).

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
a switching station including a switch processor capable of receiving call data from at least one dial-up communication source and a switching computer means capable of processing call data; said switching computer means controlling said switch processor;	Processing systems P_1 ... P_n (Fig. 1), including the call data analyzer 20a and the processor unit 92 and associates structures (Fig. 4) "The processing unit 92 may take the form of a mini-computer program to accommodate the function of various applications ..." (p.19:15-17; c.10:7-9) Call Data Analyzer "The interface 20 incorporates modems, tone decoders, switching mechanisms, DNIS and ANI capability (call data analyzer 20a) along with voice interface capability." (p.8:25-28; c.4:50-53) Source: Remote Terminals T_1 ... T_n (Fig. 1)

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
communication means capable of capturing call data received by said switch processor, said call data including automatic number identification and a personal identification number;	ANI "ANI capability is a similar function whereby the digital data indicates the calling number with the calling terminal digital signals. Both (DNIS and ANI) capabilities are available for use with equipment as the interface 20 and to provide control through the call data analyzer 20a." (p.8-9:35-5; c.4:61-65). Personal Identification Number (PIN): "Other applications or programs also may present a critical need for positively verifiable identification to the extent that credit card numbers and/or personal identification numbers may be employed." (p.11-12:34-2; c.6:24-28). " ...[t]he processors might also verify identification data proffered by a caller. Such data might take the form of a credit card number or a personal identification number." (p.18-19:31-1; c.9:58-61). " ...Approval may require the assignment of a personal identification number to the child player as qualifying identification data". (p.33:8-10; c.16:55-57). "Specifically, the random number generator 101 (Fig. 4) provides a number which may be encrypted along with other identification data as the caller's personal identification to provide a numerical designation that is registered in storage 97." (p.37:24-29; c.18:65-19:1).

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
said communication means capturing call data at the front side of the call data received by the switch processor and supplying said call data to the switching computer means, and capable of supplying processed data from the switching computer means to the switching station;	"In accordance with various applications or operating format, the qualification unit 93, the sequencer 94 and the designation unit 96 operate preliminarily with respect to individual callers. Generally, these units qualify or test callers for entitlement, develop a sequence-of-calls record and provide forms of designations for callers that may be authenticated. As described in detail below, the units function in sequence to accomplish such operations and accordingly are each individually connected to the processing unit 92 and the buffer storage 97." (p.19:29-20:5; c.10:24-31).

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
said switching computer means capable of obtaining data for at least one parameter related to the identification data in addition to said call data for the switching computer means to act upon in processing call data and determining from said data from the front side of the call data and additional parameter whether the attempted call is placed by a caller in good standing in accordance with parameters associated with the identification data;	Clock CL (Fig. 1) Uses/Month (Fig. 7) Use rate calculator 100 (Fig. 4) "Note that the table 99 may be a large shared unit that tabulates each of the key numbers and accounts for their use. If the caller has identified a proper key number, the process proceeds and the key number is accounted, i.e., incremented or decremented to the limit of use if any." (p.36:19-24; c.18:29-32) "If the response is not valid or entitled, for example contains an inappropriate number of digits or has been used to a point of excess, the operation of block 46 is initiated again queing the voice generator 40 (Fig. 1)." (p.13:14-18; c.7:6-10) "... Restricted to a limited number of uses for defined intervals of time. For example, a person might be entitled to play the lottery a limited number of times or to the extent of a limited dollar value during a predetermined interval." (p.24:30-34; c.12:49-53). "For example, a list may be preserved by a use-rate calculator to implement a consumable key operation. That is, a user is qualified to a specific limited number of uses during a defined interval." (p.18:19-23; c.9:47-50). "... The designation unit 96 operates during interval T3 to provide the caller with a designation for the current transaction and if applicable, updates the file as to current use or dollar value remaining for the callers use." (p.26:6-10; c.13:23-27)
said switching computer means being capable of disallowing completion of a call through the switching station if it is determined from processing of the call data and the additional parameter by the switching computer means that the call is not placed by a caller in good standing; and	In the event that the criteria listed in the preceding element are not met, a caller is not entitled to proceed. For example, in Fig. 3, if the answer to the "IS RESPONSE GOOD" decision block 44 is YES, then the caller is permitted to continue.

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
said switching computer means being capable of interrupting and terminating said call in progress through the switch processor if said switching computer means determines by data processing that the available account status associated with the identification data has been reached during the call.	"The system next proceeds to the test mode as indicated by the block 76 (Fig. 3). If the caller provides the correct acknowledgment digits, the data is confirmed in the record as indicated by the block 80 and is registered in the cell C1 (Fig. 2). Additionally, the voice generator is sequenced as indicated by the block 82 (Fig. 3) to indicate the close of the communication and the transaction is terminated as represented by exit block 84." (p.17:9-17; c.9:3-11). Specific examples of formats contemplate discontinuing the call if validation processing determines the caller is not continuing in good standing. "a person might be entitled to play the lottery a limited number of times or to the extent of a limited dollar value during a predetermined internal." (p.24:32-34; c.12: 50-53). "Normally at the conclusion of the bidding on a particular item, the contents of the cells in the memory 98 would be purged with only the final bidders being held in general memory within the processing unit 92." (p.32:3-7; c.16:16-19). "If the caller has identified a proper key number, the process proceeds and the key number is accounted, i.e., incremented or decremented to the limit of use if any." (p.36:21-24; c.18: 29-32) "According to the described format, after an interval of play, the processing unit, as the unit 92 (Fig. 4), operate to isolate a subset of caller-players who have amassed the highest scores." (p.34:22-25; c.17:33-36).

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
40 (30). The telephone system of the type controllable by identification data as described in claim 39, further comprising a voice response device in electrical communication with said switch processor and said switching computer means, and capable of being in communication with at least one remote telephone, said voice response device with said switching computer means providing at least one of the following: to deliver a message to a caller, to make a call through the telephone system, and to prevent a caller making a call through the telephone system.	The system includes a voice generator. (See, e.g., Fig. 3 "Cue Voice Generator", blocks 42, 56, 72 and 86).
41 (31). The telephone system of the type controllable by identification data as described in claim 39, wherein said switch computer means performs a repeated failed attempts determination and directs the switching station through the communication means to prevent repeated attempts to enter the telephone system from a particular dial-up communication source by using a series of invalid personal identification numbers with a predetermined period of time.	As a further check during the qualification stage, the use-rate calculator 100 may function to determine whether or not an excessive number of calls have originated from the designated number. Thus, consideration involves calls or value with reference to a predetermined period of time. Again, a shared calculator may be used or addressing may obtain selectivity on the basis of calling numbers. If a large number of calls have originated from a single telephone terminal, a fraudulent situation may be suggested." (p.36:27-37:2; c.18;35-44).
42 (32). The telephone system of the type controllable by identification data as described in claim 39, further comprising monitoring computer means electrically connected to said switching computer means and capable of storing call data, and a data storage server means electrically connected to the monitoring computer means and capable of access by customers to the telephone system to provide current billing information to customers.	The system includes memory 98. "Note that the communication facility C has a customer billing structure B that is interfaced by the system." (p.10:21-23; c.5:45-47) "The cells indicate sequences of calling and also may contain billing data where appropriate." (p.40:13-15; c.20:21-22)

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
43 (33). The telephone system of the type controllable by identification data as described in claim 39, further comprising a voice response means being capable of communication with said switching computer means and in dial-up communication with callers to the telephone system, and capable of providing an oral report of current account status card users.	"... the system may inform callers of their success during the course of the interface telephone call. That is, the callers might simply be informed by cueing the voice generator: Your answers are correct and in accordance with the program game, you will now be entered in the sweepstakes draw for the prize ..." (p.40:28-33; c.20:34-40)
44 (34). A telephone system of the type controllable by identification data as described in claim 39 wherein the switching computer means determines from the call data and the data of the additional parameter at least one of the following for the switching station to act upon in processing call data: unauthorized calling by the user.	As a further check during the qualification stage, the use-rate calculator 100 may function to determine whether or not an excessive number of calls have originated from the designated number. Thus, consideration involves calls or value with reference to a predetermined period of time. Again, a shared calculator may be used or addressing may obtain selectivity on the basis of calling numbers. If a large number of calls have originated from a single telephone terminal, a fraudulent situation may be suggested." (p.36:27-2; c.18:35-44).
45 (35). A telephone system of the type controllable by identification data as described in claim 39 wherein the switching station includes in addition an internal buffer capable of at least temporarily storing call data received by the switch processor, a conductor means capable of providing electrical communication of all data from the switch processor to the buffer, and said communication means captures call data transparent to call data transfer from the switch processor to the internal buffer.	Buffer storage 97
46 (36). A telephone system of the type controllable by identification data as described in claim 45 wherein said communication means is electrically connected to such conductor means.	Various connecting lines as shown, for example, in Fig. 4.
47 (37). A telephone system of the type controllable by identification data as described in claim 39 wherein the communication means includes a port in the switch processor.	

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
48 (38). A method of handling telephone calls by use of identification data, comprising the steps of:	"In general, the present invention comprises a telephonic-interface system and related process for selectively utilizing both analog (voice) and digital telephonic communication in a variety of different interface formats or programs, as to select or qualify a set of callers, enable positive identification of at least certain of the callers in the set, ..." (p.2:21-27; c.1:49-56)
providing a switching station including a switch processor for receiving call data from at least one source capable of dial-up communication with said switch processor by use of identification data and a switching computer means for processing call data received by said switch processor;	Processing systems P_1 ... P_n (Fig. 1), including the call data analyzer 20a and the processor unit 92 and associates structures (Fig. 4) "The processing unit 92 may take the form of a mini-computer program to accommodate the function of various applications ..." (p.19:15-17; c.10:7-9) Call Data Analyzer "The interface 20 incorporates modems, tone decoders, switching mechanisms, DNIS and ANI capability (call data analyzer 20a) along with voice interface capability." (p.8:25-28; c.4:50-53) Source: Remote Terminals T_1 ... T_n (Fig. 1)

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
capturing call data received by said switch processor, said call data transmitted at dial-up including automatic number identification and a personal identification number;	ANI "ANI capability is a similar function whereby the digital data indicates the calling number with the calling terminal digital signals. Both (DNIS and ANI) capabilities are available for use with equipment as the interface 20 and to provide control through the call data analyzer 20a." (p.8:35-9:5; c.4:61-65). Personal Identification Number (PIN): "Other applications or programs also may present a critical need for positively verifiable identification to the extent that credit card numbers and/or personal identification numbers may be employed." (p.11:34-12:2; c.6:24-28). " ...[t]he processors might also verify identification data proffered by a caller. Such data might take the form of a credit card number or a personal identification number." (p.18:31-19:1; c.9:58-61). " ...Approval may require the assignment of a personal identification number to the child player as qualifying identification data". (p.33:8-10; c.16:55-57). "Specifically, the random number generator 101 (Fig. 4) provides a number which may be encrypted along with other identification data as the caller's personal identification to provide a numerical designation that is registered in storage 97." (p.37:24-29; c.18:65-19:1).

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
delivering at least some captured data to said switching computer means;	"In accordance with various applications or operating format, the qualification unit 93, the sequencer 94 and the designation unit 96 operate preliminarily with respect to individual callers. Generally, these units qualify or test callers for entitlement, develop a sequence-of-calls record and provide forms of designations for callers that may be authenticated. As described in detail below, the units function in sequence to accomplish such operations and accordingly are each individually connected to the processing unit 92 and the buffer storage 97." (p.19:29-20:5; c.10:21-31).
supplying to said switch computer means at least one additional parameter related to the identification data to determine good standing;	Clock CL (Fig. 1) Uses/Month (Fig. 7) Use rate calculator 100 (Fig. 4)

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
processing in the switching computer means call data in relation to the received additional parameter data to determine if calls are placed and continued in good standing;	"Note that the table 99 may be a large shared unit that tabulates each of the key numbers and accounts for their use. If the caller has identified a proper key number, the process proceeds and the key number is accounted, i.e., incremented or decremented to the limit of use if any." (p.36:19-24; c.18:27-32) "If the response is not valid or entitled, for example contains an inappropriate number of digits or has been used to a point of excess, the operation of block 46 is initiated again queing the voice generator 40 (Fig. 1)." (p.13:14-18; c.7:6-10) "... Restricted to a limited number of uses for defined intervals of time. For example, a person might be entitled to play the lottery a limited number of times or to the extent of a limited dollar value during a predetermined interval." (p.24:30-34; c.12:49-53). "For example, a list may be preserved by a use-rate calculator to implement a consumable key operation. That is, a user is qualified to a specific limited number of uses during a defined interval." (p.18:19-23; c.9:47-50). "... The designation unit 96 operates during interval T3 to provide the caller with a designation for the current transaction and if applicable, updates the file as to current use or dollar value remaining for the callers use." (p.26:6-10; c.13:23-27)
preventing connection of telephone calls if validation determines the call is not made by caller in good standing; and	In the event that the criteria listed in the preceding element are not met, a caller is not entitled to proceed. For example, in Fig. 3, if the answer to the "IS RESPONSE GOOD" decision block 44 is YES, then the caller is permitted to continue.

CLAIM LANGUAGE	EXEMPLARY SPECIFICATION SUPPORT
preventing continuation of telephone calls if validation determines the call is not continuing in good standing.	"The system next proceeds to the test mode as indicated by the block 76 (Fig. 3). If the caller provides the correct acknowledgment digits, the data is confirmed in the record as indicated by the block 80 and is registered in the cell C1 (Fig. 2). Additionally, the voice generator is sequenced as indicated by the block 82 (Fig. 3) to indicate the close of the communication and the transaction is terminated as represented by exit block 84." (p.17:9-17; c.9:3-11). Specific examples of formats contemplate discontinuing the call if validation processing determines the caller is not continuing in good standing. "a person might be entitled to play the lottery a limited number of times or to the extent of a limited dollar value during a predetermined internal." (p.24:32-34; c.12:50-53). "Normally at the conclusion of the bidding on a particular item, the contents of the cells in the memory 98 would be purged with only the final bidders being held in general memory within the processing unit 92." (p.32:3-7; c.16:16-19). "If the caller has identified a proper key number, the process proceeds and the key number is accounted, i.e., incremented or deremented to the limit of use if any." (p.36:21-24; c.18: 29-32) "According to the described format, after an interval of play, the processing unit, as the unit 92 (Fig. 4), operate to isolate a subset of caller-players who have amassed the highest scores." (p.34:22-25; c.17:33-36).

Applicant proposes two counts for this interference. The counts are set forth separately below. For each count, Applicant contends that the differences between the claims of the Marshall '636 patent that are copied and the prospective count are not patentably distinct. Accordingly, there is an interference-in-fact. 37 C.F.R. §1.601(j). Applicant will identify the pending claims of Applicant's case which correspond to the counts.

Count I

A telephone system of a type controllable by identification data, comprising:

a switching station including a switch processor capable of receiving call data from at least one dial-up communication source and a switching computer means capable of processing call data;

said switching computer means controlling said switch processor;

communication means capable of capturing call data received by said switch processor, said call data including automatic number identification and a personal identification number;

said communication means capturing the call data at the front side of the call data received by the switch processor and supplying said call data to the switching computer means, and capable of supplying processed data from the switching computer means to the switching station;

said switching computer means capable of obtaining data for at least one parameter related to the identification data in addition to said call data for the switching computer means to act upon in processing call data and determining from said data from the front side of the call data and additional parameter

whether the attempted call is placed by a caller in good standing in accordance with parameters associated with the identification data;

said switching computer means being capable of disallowing completion of a call through the switching station if it is determined from processing of the call data and the additional parameter by the switching computer means that the call is not placed by a caller in good standing; and

said switching computer means being capable of interrupting and terminating said call in progress through the switch processor if said switching computer means determines by data processing that the available account status associated with the identification data has been reached during the call.

The Marshall '636 Patent

Claim 1 of the Marshall '636 patent corresponds substantially to Count I. Whereas claim 1 of the Marshall '636 patent recited in the preamble that the telephone system was "of a type controllable by travel cards", the Count foregoes recitation of the printed card stock in favor of the controlling signals, namely the identification data entered by the caller. Appropriate language substitutions deleting reference to the print stock "travel card" and inserting the identification data are made in the Count.

The Katz Application

Newly presented claim 39 corresponds exactly to Count I. Applicant's claims 29-37 and 40-47 correspond substantially to Count I. As set forth above, Applicant's new claims are supported by the specification, without the addition of new matter, and in certain instances, correspond exactly to Count I. The proposed Count I should be adopted, and as to Marshall '636 patent, claims 1-16 be designated as corresponding to

the Count, and Applicant's claims 29-37 and 39-47 be designated as corresponding to the Count.

Count II

A method of handling telephone calls by use of identification data, comprising the steps of:

providing a switching station including a switch processor for receiving call data from at least one source capable of dial-up communication with said switch processor by use of identification data and a switching computer means for processing call data received by said switch processor;

capturing call data received by said switch processor, said call data transmitted at dial-up including automatic number identification and capturing a personal identification number;

delivering at least some captured data to said switching computer means;

supplying to said switch computer means at least one additional parameter related to the identification data to determine good standing;

processing in the switching computer means call data and personal identification data in relation to the received additional parameter data to determine if calls are placed and continued in good standing;

preventing connection of telephone calls if validation determines the call is not made by a caller in good standing; and

preventing continuation of telephone calls if validation determines the call is not continuing in good standing.

The Marshall '636 Patent

Claim 17 of the Marshall '636 patent corresponds substantially to Count II. Further, claims 18 and 19 should be designated as corresponding to the Count.

The Present Application

Applicants claim 48, newly added by this Amendment, corresponds exactly to Count II, and claim 38 corresponds substantially to the Count.

Conclusion

Applicant respectfully requests a declaration of interference between the Marshall '636 patent and the instant Katz application, having the Counts given above, with the designated claims corresponding to the Count.

Respectfully submitted,

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